



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/771,467	12/20/96	VAN VORIS	P B-1075-F2C2

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EXAMINER

LEVY, N

ART UNIT PAPER NUMBER

1502

DATE MAILED: 12/22/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/19/97☒ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-46-29 is/are pending in the application.
Of the above, claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-4, 6-29 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number)
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Receipt is acknowledged of request for time and amendment (October 14, 1997) and Prior Art (October 14, 1997). The Prior Art, IDS, have been entered and considered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendment to the specification was not entered; please re-submit specifying "add the following terms on line 1, page 25 after metallized --", etc.

Claims 3, 7, 12-14, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no proper antecedent for in situ polymerization - claim 1 has no prepolymer, it only presents a only polymer. The rejection of high and low density polyethylene is maintained, in the absence of

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support document and declaration of competent dates therefor. There is no support for any high or low density prepolymer, however (claims 9 and 12) rejection is maintained. The rejection of claims 18 and 19 is maintained. By examiner's interpretation, "proximate" includes one mode wherein there is no direct contact with wood, it is, untouched - this is supported by applicants rendition of proximate in the specification at page 10, lines 28-30 - sufficiently near, or in contact with soil; there is no disclosure of an untouched, or proximate placement, which results in fully or partially impregnating a zone or the whole of a wooden structure at a distance - yet, that is in essence the claim language. By no stretch of the imagination does this examiner equate an area one of protection, constituting a presence of pesticide, with an effective level throughout a wooden structure or

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zone thereof, in contact with the area, or at a distance from the area or any device. Applicant is invited to either point to disclosure as claimed, or amend in accord with supportive disclosure, to recite a protective zone outside the wood, but proximate the device, or a concentration and amount effective to prevent deterioration, (if this is supportable) for example.

Claims 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The discrepancy in examiners mind between protection of the wood, as indicated above under H2 rejection, and impregnation or howsoever, arriving at a pesticide concentration within wood, not in

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contact with the device, but still, proximate to it has not been remedated - thus, the rejection is maintained - Applicant is invited to point out where one is shown, in the specification, that an effective concentration of pesticide is present within the wood, in order to warrant withdrawal of this rejection without amendment.

Claims 1-4 and 6-29 are provisionally rejected under the judicially created doctrine of double patenting over claim and disclosure of copending Application No. 08/350,432. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant

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application are claiming common subject matter, as follows: Polymers, methods and pesticides are the same

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1-4 and 6-29 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-73 and disclosure of copending Application No. 08/484,967. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the

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referenced copending application and the instant application are claiming common subject matter, as follows: The same polymers, pesticides and methods are utilized in both applications.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant has amended the specification, excluding priority to 08/484,967, but has not substituted a declaration reflecting removal of 08/484,967, for which benefit is claimed under Title 35, 120. Please correct.

Applicant's arguments filed October 17, 1997 have been fully considered but they are not persuasive.

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Applicant argues, re double patenting, provisional rejection should be made. Examiner has made provisional rejections. Applicants arguments re 112 issues have been seriously considered, and explanations accepted, but for the exceptions maintained rejected, for the reasons set forth in the rejections. Support is requested claim language, the "high", "low" terminology, and the difference of interpretation of examiner and applicant vis a vis the pesticide content of the wood proximate the device.

Claims 1, 2, 6-13, 16, 19, 20, 22-24 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Zimmerman - 5,139,566.

Soil treatment, providing active agent controlled release (column 2, summary) including fungicides (column 3, lines 6-11) and a hydrophobic polymer polyolefins, PVC, and a carbon black carrier (column 3) is disclosed as is the instant method of making, liquid pesticides are used.

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See example - low density polypropylene and carbon black with active are mixed. Application to soil would include, inherently such areas where wood is, since there is no limitation on what soil and crops are to be protected. Also, it is noted that the particular polymer used and density thereof is a function of the intended active (column 3, lines 36-42) thus inherently inclusive of both high and medium density polymers, in addition to the exemplified low density polyethylene. since no limitation is put on the pesticides, they include those that are of liquid nature, now vapor pressure, and water soluble. Note also, application of the web is proximate objects to be protected (column 2, line 50 and 51). The instant methods are shown, no patentable weight given to the non critical order of the instant inventive steps, nor to the future intended use, nor to placement proximate to wood in particular.

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The instant sheets are shown as Zimmerman webs, while sleeves are Zimmerman pipe wraps.

Claims 1-4, 6-16 and 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chemical web in view of Fahslstrom, Zimmerman and of record and Sjorn - 4,971,796.

Chloropicrin is shown as effective to prevent decay when placed proximate to wood, by maintaining an effective active level throughout the wood. Delivery forms were not discussed. Zimmerman (above) discloses them. Fahlstrom disclose any polypropylene, polyethylene polymers may be used to form a container (column 4) including chloropicrin fungicide, applied proximate to wood to be protected (column 5, bottom) example 1. A plug is used to cap the container. Efficacy is within 6-72 hours. Zimmerman (above) teaches fungicidal/pesticidal slow release matrices of

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the instant invention. Since chloropicrin is a favored wood fungicide, it would be obvious to one of ordinary skill in the wood protection arts to utilize chloropicrin in or on wood, in closed container to decrease loss and non target species toxicity, utilizing Fahlstrom plastic delivery device for initially high release rate, with inclusion of Zimmerman's matrices for continued slow release. Sjogren further shows (column 10 that carbon black (carbon particular).

Controls the release rate of pesticides in nonencapsulated, encapsulated or micro encapsulated form. Thus incorporating this feature, or the Sjogren capsules in Fahlstrom would facilitate control of release rate of the desired pesticide Sjogren shows these to include the instant fungicides (column 5, lines 30-44).

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Thus, the artisan would find it obvious to prepare particular ingredient combinations, concentration and ratios of ingredients, depending upon the target species, desired number of application, length of time for desired protection ease of handling safety to non target species, degradation.

It has not clearly been established by an objective showing of some additional unusual and/or unexpected result that the administration of the particular polymer, active, carrier or the sequence of mixing steps provides any greater level of prior art expectation is claimed. Further, no criticality, or objective showing of nonobvious or unexpected results is seen by the applicant to distinguish over the prior art.

Applicant's arguments with respect to claims 1-4 and 6-29 have been considered but are moot in view of the new ground(s) of rejection.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Applicant is requested to present any literature as prior art disclosing the instant fungicides with hydroxyapatite carriers within or mixed with hydrophobic polymers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday-Friday from 7:00 a.m. to 5:30 p.m.

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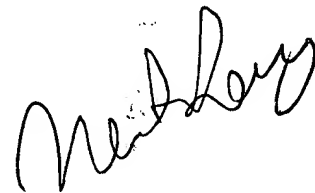
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on (703) 308-2927. The fax phone number for this Group is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

Neil Levy:cb
Primary Examiner

Thursday, December 18, 1997



NEIL S. LEVY
PATENT EXAMINER
GROUP 1500